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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,994	02/05/2001	Theodore W. Frank	3956-4004	7062
7590 07/29/2004			EXAMINER	
MORGAN & FINNEGAN, L.L.P. 345 Park Avenue New York, NY 10154			LE, UYEN T	
			ART UNIT	PAPER NUMBER
			2171	

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/776,994

Applicant(s)

FRANK ET AL.

Examiner

Uyen T. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6Aug02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 6, 65 are objected to because "prior incidents of this type" should be changed to --prior similar incidents--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because claim 1, last line "the information" is ambiguous.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7, 32-34, 36, 37, 53, 64 are rejected under 35 U.S.C. 102 (e) as being anticipated by Thielges al (US 2002/0138289).

Regarding claim 1, Thielges discloses all the claimed subject matter (see the abstract, Figures 2-4, pages 3,4). The claimed "receiving information about an incident" is met by step 202 (see Figure 2). The claimed "extracting information...record of the incident" is met by steps 206, 208. The claimed "dynamic generation...information" is met by the steps shown in Figures 3, 4). Clearly the workflow is site specific and dynamically generated since each incident occurs at a specific site and needs be resolved in a dynamic manner in the method of Thielges.

Regarding claim 2, the claimed "sending a recommendation...occurrence" is met by the fact that an RFQ is created and issued (see step 310, Figure 3).

Regarding claim 3, Thielges discloses the claimed "sending information...to the incident" (see 0034).

Regarding claim 4, Thielges discloses an investigation checklist for use as a guide (see 0063).

Regarding claim 5, Thielges discloses performing expert system interviews when Thielges shows how to generate user next action (see Figure 13).

Regarding claim 6, Thielges discloses searching for data on prior incidents and history of parties involved in the incident (see Figure 16).

Regarding claim 7, Thielges discloses the claimed "routing variances...incidents" (see Figure 19).

Claims 32-34 correspond to a system for claims 1-3, thus are rejected for the same reasons stated in claims 1-3 above.

Claims 36, 37 correspond to a system for claim 6, thus are rejected for the same reasons stated in claim 6 above.

Claim 53 recites a system for part of claim 1, thus is rejected for the same reasons stated in claim 1 above.

Claim 64 merely differs from claim 1 by the last paragraph. The method of Thielges clearly stores information for utilization by compliance personnel (see 0069).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21, 22, 25-27, 46, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thielges al (US 2002/0138289).

Regarding claim 21, Thielges discloses a method for providing a computerized compliance management system including “extracting...of the incident” (see the abstract, Figures 2-4, pages 3,4, steps 206, 208), “guiding...to the incident” (see Figure 13, 0063). Although Thielges does not specifically show “receiving updated information...resolved”, it would have been obvious to one of ordinary skill in the art to do so in order to gather all information for the incident report.

Regarding claim 22, Thielges discloses ‘sending a notice...to be collected” (see Figure 4).

Regarding claim 25, Thielges teaches “maintaining a secure...interfaces” (see Figure 12, 0060).

Regarding claim 26, Thielges teaches “validating...of the incident” (see 0069).

Regarding claim 27, although Thielges does not specifically show “offering...to the incident”, it would have been obvious to one of ordinary skill in the art to do so in order to provide training to improve compliance.

Claims 46, 47 corresponds to a system for claims 21, 22, thus are rejected for the same reasons stated in claims 21, 22 above.

5. Claims 8-20, 23, 24, 28-31, 35, 38-45, 48-52, 54-63, 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thielges al (US 2002/0138289), in view of Lettich et al (US 2002/0049622).

Regarding claim 8, although Thielges does not specifically show “auditing...incident”, it is well known in the art as shown by Lettich to include such information about an incident (see 0160). Therefore, it would have been obvious to one of ordinary skill in the art to include such information while implementing the method of Thielges in order to perform a root cause analysis of the failure as taught by Lettich.

Regarding claim 9, clearly data validity has to be maintained in the process of Thielges and Lettich by minimizing data modification as claimed since the method reports an incident and performs analysis of data gathered.

Claim 10 merely differs from claim 1 by adding “from a user” and by the last paragraph of “measuring performance...improvements”. Thielges clearly discloses that

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information about an incident is received from a user (see step 202, Figure 2). Although Thielges does not specifically show measuring performance of tasks as claimed, it is well known in the art to do so as shown by Lettich (see 0123). Therefore, it would have been obvious to one of ordinary skill in the art to include such features while implementing the method of Thielges in order to perform root cause analysis of failures as taught by Lettich.

Regarding claim 11, Thielges/Lettich combination teaches the claimed "sending a recommendation...performance" (see step 310, Figure 3, Thielges).

Regarding claim 12, Thielges/Lettich combination teaches "generating forms for incident and data capture" (see 0140, Lettich).

Regarding claim 13, Thielges/Lettich combination teaches "generating a report about the incident" (see 0140, Lettich).

Regarding claim 14, Thielges/Lettich combination teaches "guiding the user...incident" (see Figure 13, 0063, Thielges).

Regarding claim 15, Thielges/Lettich combination teaches "maintaining a secure...interfaces" (see Figure 12, 0060, Thielges).

Regarding claim 16, although Thielges and Lettich do not specifically show generating a calendar for follow-ups on the incident, it would have been obvious to one of ordinary skill in the art to do so in order to evaluate how effective the corrective actions are.



Regarding claim 17, although Thielges and Lettich do not specifically show creating benchmarks, it would have been obvious to one of ordinary skill in the art to do so in order to evaluate the incident management.

Regarding claim 18, although Thielges and Lettich do not specifically show involving a government agency in the process of responding to the incident, it would have been obvious to one of ordinary skill in the art to include any agency as needed in order to respond to the incident.

Regarding claim 19, the report of Thielges/Lettich has to include internal and external costs since it involves an incident (see Figures 2-4, Thielges).

Regarding claim 20, Thielges/Lettich combination teaches claim management cost (see 0058, Thielges).

Regarding claim 23, although Thielges does not specifically show measuring performance of tasks related to the incident as claimed, it is well known in the art to do so as shown by Lettich (see 0123). Therefore, it would have been obvious to one of ordinary skill in the art to include such features while implementing the method of Thielges in order to perform root cause analysis of failures as taught by Lettich.

Regarding claim 24, although Thielges and Lettich do not specifically show "executing...deficiency", it would have been obvious to one of ordinary skill in the art to include such features in order to provide adequate training to users.

Claims 28, 31 are essentially a combination of claim 10 and part of claim 21, thus are rejected for the same reasons stated in claim 10, 21 above.

Regarding claim 29, Thielges/Lettich combination teaches the claimed "sending a recommendation...occurrence" (see step 310, Figure 3).

Regarding claim 30, although Thielge and Lettich do not specify tracking the progress of the incident, it would have been obvious to one of ordinary skill in the art to do so in order to evaluate the incident management.

Claim 35 corresponds to a system for claim 30, thus is rejected for the same reasons stated in claim 30 above.

Claims 38-45, 48-52, 54-63, 65-67 essentially recite the same limitations of claims 8-11, 14-18, 21, 23, 24, 26, 28-31, thus are rejected for the same reasons stated in claims 8-11, 14-18, 21, 23, 24, 26, 28-31 above.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McDonough et al (US 2004/0049345) teach distributed, collaborative workflow management software,

Walker et al (US 2001/0047286) teach task and personnel verification and tracking system and method.

Barnard et al (US 5,586,252) teach system for failure mode and effects analysis.

Leymann et al (US 6,065,009) teach events as activities in process models of workflow management systems.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 703-305-4134. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21 July 2004



**UYEN LE**  
**PRIMARY EXAMINER**